REMARKS

Claims 1, 3-17 and 20-36 are now in the application.

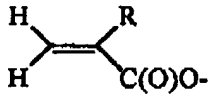
Claims 1 and 20 have been amended to include recitations from claim 2 and accordingly claim 2 has been canceled. Therefore, this amendment does not introduce any new matter, and does not raise any new issues.

Claims 1-6, 9-13, 17, 20-22 and 24-36 were rejected under 35 U.S.C. §102(b) as being anticipated by EP 0261 942. EP 0261942 does not anticipate these claims.

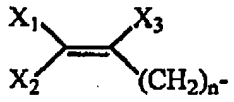
The polymerizable carbon-carbon double bond-containing group in amended claims 1 and 20 is represented by the general formula (1):

$-OC(O)C(R)=CH_2$ (1)

i.e.



On the other hand, the macromonomer suggested in EP 0161942 has an end group of the formula $C(X_1)(X_2)=C(X_3)(CH_2)n-$; i.e.



Please see page 2, lines 31-34 and page 3, lines 19-21.

This end group differs significantly from formula (1) in amended claims 1 and 20.

Thus EP 0261942 fails to disclose the invention of amended claims 1and 20. Since claims 3-6, 9-13, 17, 21, 22 and 24-36 depend from claim 1 or 12, likewise, these claims are not anticipated.

Claims 1 and 13-15 were rejected under 35 U.S.C.§102(b) as being anticipated by JP50-150; 793. Japan 50-150, 793 does not anticipate claims 1 and 13-15.

In the previous Office Action dated August 14, 2002 (Paper No. 6), original claims 18 and 20 were not rejected over JP 50-150,793. See page 6 of that Office Action.

In response to said Office Action, the original claim 1 was amended to include the recitations from original claim 18, and amended original claim 20 was amended to place it in an independent form, as clearly shown in the Amendment filed on January 14, 2003.

Therefore the rejection over JP'793 should have been rendered moot by the prior Amendment.

Also, as mentioned on pages 5 and 6 of our prior Amendment that the rejection over JP50-150,793 has been rendered moot by the amendments to claims 1 and 20. Thus the Examiner's statement that there is no argument provided by Applicants with regard to JP'793 on page 6 of the instant Office Action is not proper.

In fact, JP'793 does not disclose a macromonomer having a Mw/Mn of less than 1.8, or living radical polymerization because JP'793 merely redox polymerization.

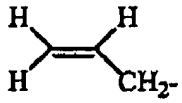
Additionally, the Examiner does not reject claim 2 or 20 over JP'793 in the instant Office Action. Since amended claims 1 and 20 include the recitation from claim 2, the rejection over JP'793 has also been rendered moot for this reason.

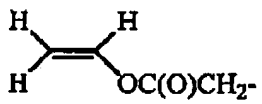
Claims 1-8, 10-13, 17, 20-24 and 29-36 were rejected under 35 U.S.C.§102 (b) as being anticipated by U.S.Patent 5,807,937 or 5,789,487 to Matyjaszewski et al.

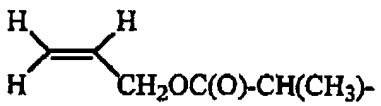
Claims 13-16, 25-28, 31 and 32 were rejected under 35 U.S.C.§103 (a) as being unpatentable over U.S.Patent 5,807,937 or 5,789, 487 to Matyjaszewski et al.

US Patents 5,807,937 and 5,789,487 fail to anticipate and fail to render obvious the above claims.

US 5,807,937 suggests on Table 11 polystyrene macromonomers prepared using $BrCH_2$-$CH{=}CH_2$, $ClCH_2$-$COOCH{=}CH_2$ (vinyl chloroacetate), CH_3CHBr-$COOCH_2CH{=}CH_2$ as initiators. These macromonomers have polymerizable double bonds represented by:







These groups are quite different from the above-mentioned formula (1) in amended claims 1 and 20. Please note that while the second group, which is derived from vinyl chloroacetate, has an oxygen atom directly attached to carbon-carbon double bond, the formula (1) in amended claims has a carbon atom directly attached to carbon-carbon double bond.

Accordingly US 5,807,937 does not disclose the invention of amended claim 1 or 20.

US 5,789,487 likewise, fails to disclose the macromonomer having the above-mentioned formula (1) in amended claims 1 and 20.

Thus US 5,807,937 fails to disclose the invention of amended claim 1 or 20.

The cited references fail to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. *See Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir.1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102. *See Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengessellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

Also, the cited art lacks the necessary direction or incentive to those of ordinary skill in the art to render under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 185 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch, supra,In re Burt et al.* 148 USPQ 548 (CCPA) 1966), *In re Ward,*141 USPQ 227 (CCPA 1964), and *In re Cescon,*177 USPQ 264 (CCPA 1973).

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event that the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication including any extension fees to Deposit Account No. 22-0185.

Dated: 8-21-03

Respectfully submitted,

By _____

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